

REMARKS

Claims 34, 36-49, 51-64, and 66-78 are presented for examination.

Claim Rejections - 35 USC § 101

Claims 49 and 51-63 stand rejected under 35 USC § 101 as allegedly directed to non-statutory subject matter and as directed to software per se. The rejection is traversed.

The examiner's position as stated is that "the means plus functions are not tangible and/or the specification does not specifically describe the structures of that (*sic*) perform the means plus functions as being implemented by hardware structure," apparently because, the examiner contends, the specification on page 8 lines 13 – page 9 line 20 describes means for retrieving, generating, and transmitting as software. Therefore, the examiner contends, the rejection is proper. Applicants respectfully disagree.

The rejection is wrong in law. The examiner appears to confound an apparatus claim, which unquestionably falls within the scope of patentable subject matter (as a machine, manufacture, or composition of matter) with a process claim, which may not. Nevertheless, even a process claim is patent-eligible under section 101 if it is tied to a particular machine or apparatus. Gottschalk v. Benson, 409 U.S. 63, 70 (1972). Referring to claim 49, it can be seen that the recited means are indeed tied to tangible elements, such as a hardware token, a host, and a memory separate from the token. Therefore, even if claim 49 was a process claim, which it is not, it would not be excluded from patentability under section 101, because it is tied to a particular machine or apparatus.

Furthermore, as applicants pointed out in the reply to the previous action, the cited portion of the specification is replete with references to a host computer, a hardware token, and a

server, all performing certain described functions, but does not disclose the claimed means for retrieving, regenerating, and transmitting as software. If the examiner continues to maintain that it does, it is respectfully requested that the examiner quote the exact portion and cite the precise location where that description exists. Moreover, even if it were true that the specification disclosed the claimed means as being software (which it does not), it would still be understood by one of ordinary skill in the art that the means would necessarily also include hardware sufficient to run the software and cause the associated hardware to perform the functions described, and could not possibly be simply software *per se*.

Based on the remarks presented above, reconsideration and withdrawal of the rejection of claims 49, and 51-63 under 35 USC § 101 are respectfully requested.

Claim Rejections - 35 USC § 103

Claims 34, 38-44, 49, 53-59, 64, and 68-74 stand rejected under 35 USC § 103(a) as being allegedly unpatentable over Iijima (US Patent 5,225,664) in view of Ho et al. (US PG Pubs 20030143989 A1) and Caci et al. (US Pub. 2007/0145125 A1). The rejection is traversed.

Regarding claims 34, 49, and 64, the examiner admits that the combination of Iijima and Ho fails to disclose retrieving a value X from a memory separate from a token accessible to an authenticating entity, wherein the value X is generated from a non-varying computer fingerprint F of the host and an identifier P securing access to the token, wherein the host fingerprint F is computed at least in part from non-varying host information C based on a unique characteristic of the host. The examiner relies on Caci for that feature, citing paragraphs 51-54, claim 1, and figs. 8 and 11. However, Caci does not disclose or suggest that feature, at the cited locations or elsewhere. Instead, at the cited locations, Caci teaches misaligning a memory location address of

a memory in a handheld appliance based on a generated random number, aligning the memory location address only when a smart card is inserted into the appliance, and storing and retrieving private information to and from the misaligned memory location when the card is inserted into the appliance, thereby making the private information unavailable when the card is not inserted. Caci does not disclose or suggest, at the cited location or elsewhere, generating a non-varying computer fingerprint based on a unique characteristic of a host as claimed, such as a unique processor serial number, NIC MAC address, BIOS code area checksum, or the like (as described at page 7, line 16 – page 8, line3).

Thus, the combination of Iijima, Ho, and Caci does not disclose or suggest this feature, which is present in claims 34, 49, and 64. For at least that reason, the rejection of those claims under 35 USC § 103(a) is not supported, and they are deemed allowable over the cited combination. Claims 38-44 depend from claim 34, claims 53-59 depend from claim 49, and claims 68-74 depend from claim 64, and those claims are deemed allowable for at least the same reasons as their base claims.

Based on the arguments presented above, reconsideration and withdrawal of the rejection of claims 34, 38-44, 49, 53-59, 64, and 68-74 under 35 USC § 102(b) are respectfully requested.

Claims 45-48, 60-63, and 75-78 stand rejected under 35 USC § 103(a) as being allegedly unpatentable over Iijima (same as above), Ho (same as above), and Caci (same as above), in view of Miura (US Patent No. 6,952,775). Claims 36-37, 51-52, and 66-67 stand rejected under 35 USC § 103(a) as being allegedly unpatentable over Iijima (same as above), Ho (same as above), and Caci (same as above) in view of Ayyagari et al. (US 2003/0208677). Applicants respectfully traverse these rejections.

Claims 45-48, 60-63, and 75-78 depend from claims 34, 49, and 64, respectively, and it is noted that Miura is relied on only for the additional features of claims 45-48, 60-63, and 75-78. Miura does not supplement Iijima combined with Ho and Caci to provide the elements of claims 34, 49, and 64 missing therefrom. Therefore, without prejudice to their own individual merits, claims 45-48, 60-63, and 75-78 are deemed allowable over the cited references for at least the same reasons that claims 34, 49, and 64 are allowable over Iijima combined with Ho and Caci.

Claims 36-37, 51-52, and 66-67 also depend from claims 34, 49, and 64, respectively, and it is noted that Ayyagari is relied on only for the additional features of claims 36-37, 51-52, and 66-67. Ayyagari does not supplement Iijima combined with Ho and Caci to provide the elements of claims 34, 49, and 64 missing therefrom. Therefore, without prejudice to their own individual merits, claims 36-37, 51-52, and 66-67 are deemed allowable over the cited references for at least the same reasons that claims 34, 49, and 64 are allowable over Iijima combined with Ho and Caci.

Conclusion

In view of the foregoing remarks, Applicants respectfully submit that claims 34, 36-49, 51-64, and 66-78 are in condition for allowance and a notice of allowance is respectfully requested.

Applicants note that, in the event allowable subject matter is not identified, the claims will have been twice rejected and an appeal to the Board of Patent Appeals and Interferences would be proper, in accordance with 35 USC 134(a).

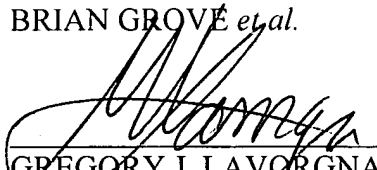
If the Examiner believes that any additional minor formal matters need to be addressed in order to place this application in condition for allowance, or that a telephone interview will help

to materially advance the prosecution of this application, the Examiner is invited to contact the undersigned by telephone at the Examiner's convenience.

Respectfully submitted,

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